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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,014	10/31/2003	Maria Ronay	YOR920030204US1 (20140-00)	8234
30678	7590	03/21/2006	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ LLP SUITE 800 1990 M STREET NW WASHINGTON, DC 20036-3425			MORILLO, JANEL COMBS	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/697,014	Applicant(s) RONAY, MARIA	
	Examiner Janelle Combs-Morillo	Art Unit 1742	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

- 3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 - (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ They raise the issue of new matter (see NOTE below);
 - (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

- 4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
- 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
- 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
- 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 9, 10, 13-29 and 31-35.
 Claim(s) withdrawn from consideration: 13-29.

AFFIDAVIT OR OTHER EVIDENCE

- 8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
- 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
- 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

- 11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
- 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
- 13. ☐ Other: _____.

Art Unit: 1742

Applicant's argument that the present invention is allowable over the prior art of record because "consisting essentially of" excludes Li has not been found persuasive. Applicant has not provided conclusive evidence that the addition of Li would substantially change the basic and novel properties of said alloy.

Applicant's argument that the present invention is allowable over the prior art of record because the prior art teaches against the formation of an oxide film has not been found persuasive. The prior art teaches there are advantages as well as disadvantages to forming an oxide film, however Tramposch still teaches that a Be-O film is beneficial to preventing the formation of sulfide films (column 1 lines 63-65). Kono also teaches that oxide films increase tarnish resistances as well (column 1 lines 45-46), even though an accidental scratch will expose the surface.

Concerning the instant oxide layer thickness of 1-10nm, as stated in the Final Rejection, though the prior art does not mention the thickness of said BeO film layer, the instant thickness is held to be within the scope of the term 'film', substantially as used by the prior art of record. The examiner further points out that the oxide protective 'film' taught by Kono is typically 2-5nm thick (column 2 lines 20-21). Though said film thickness is mentioned in connection with Al₂O₃, Kono teaches that oxides of Be are also effective to prevent tarnishings of silver alloys (column 1 lines 40-45).

Applicant's argument that the present invention is allowable over the prior art of record because the prior art does not specify the instant electronic structure configuration, has not been found persuasive. As stated in the Final Rejection, it is held to be within the scope of the prior art to have formed/used said Ag-Be contact alloy in a variety of electronic structure configurations because said prior art teaches said alloy is useful for electrical contacts, including being located in a recess or present in a BEOL structure.

When the Examiner has established a *prima facie* obviousness, the burden then shifts to the applicant to rebut. *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc). Rebuttal may take the form of "a comparison of test data showing that the claimed compositions possess unexpectedly improved properties... that the prior art does not have, that the prior art is so deficient that there is no motivation to make what might otherwise appear to be obvious changes, or any other argument... that is pertinent." *Id.* at 692-93; USPQ2d 1901. As stated above, the prior art does teach motivation to include a Be-oxide layer (for instance, 2-5 mm thick) on said silver alloy. Applicant argues "this thickness is important in avoiding significant increase in the capacitance while achieving the desired benefits from the oxide layer", but has not directed the examiner to specific evidence of unexpected results with regard to the prior art of record.

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